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In re Application of:)
Paul W. Dent)
Application No. 09/616,637)
Filed: July 26, 2000)
For: SATELLITE COMMUNICATIONS)
SYSTEM USING MULTIPLE EARTH
STATIONS)

**DECISION ON PETITION TO
WITHDRAW RESTRICTION
REQUIREMENT UNDER 37 CFR
§1.144**

This is a decision on the petition filed October 27, 2003 (Certificate of Mailing dated October 7, 2003) under 37 C.F.R. §1.144 to withdraw an outstanding restriction requirement.

The petition is **DENIED**.

On January 15, 2003 the examiner required restriction between Invention I, claims 1-35, drawn to antenna diversity classified in class 455, subclass 13.3 and Invention 2, claims 36-50, drawn to multiplexing, classified in class 370, subclass 315. The examiner further provided a requirement that if Invention 1 is elected, claims 2-6, 13-20, 24-25, and 27-32 are drawn to a first species and claims 7-12, 21-23, and 33-35 are drawn to a second species; wherein claims 1 and 26 were identified as generic claims.

The rationale used by the examiner in support of the restriction requirement included explanation that the 2 groups of claims are related as subcombinations which are distinct from each other if they can be shown to be separately useable. The examiner stated that the second group of claims has separate utility as multiplex communication.

On February 19, 2003 applicant elected the claims of Invention I, and further elected the claims of the first species of claims, while traversing the requirement. Applicant argued independent claims 36 and 41 recite "feeder link antennas" and that therefore, while both claims 36 and 41 recite multiplexer/demultiplexer features to process the received feeder signals to translate the feeder link signals into something useful; they are also

drawn to antenna diversity. Applicant cites similar arguments for independent claims 47 and 50.

On May 2, 2003, the examiner maintained the restriction requirement making it Final while rejecting elected claims 1-6, 13, 15-19 and 24-25 in a non-final Office action, also indicating that claims 14 and 20 contain allowable subject matter.

On July 16, 2003, applicant filed a response arguing the against the rejection set forth in the non-final Office action mailed May 2, 2003.

On September 25, 2003, the examiner mailed a communication informing the applicant that the application is in condition for allowance except for the presence of claims 36-50, non-elected with traverse; and giving applicant 30 days to cancel the non-elected claims or to take other appropriate action (37, CFR 1.144).

On November 4, 2003, petitioner filed the instant petition.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
 - (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

DECISION

Petitioner repeats arguments that independent claims 36, 41, 47 and 50 of Invention II are drawn to "antenna diversity" and therefore are not distinct from the claims of Invention I. Petitioner also argues that because both sets of claims deal with satellite communications between ground stations and mobile stations, via the use of antenna diversity, the claim sets are not patentably distinct.

In response, it is noted that receiving feeder link signals from at least two ground stations does not necessarily include antenna diversity, specifically "*polarization diversity*" as required by claims 1 and 26 of Invention I. In other words, Invention I relates to transmission and reception via *polarization diversity* with the satellite. There are no recitations of "*polarization diversity*" in claims 36, 41, 47 or 50. In fact, Invention II relates to the concept of ground station control or the manner in which to obtain antenna array or power amplifier drive signals. According to the specification at page 3, this invention permits multiple ground stations to use the satellites in a manner complementary to ground-based beamforming. Therefore, the examiner properly found that claims 1-35 and 36-50, respectively are drawn to different inventive concepts (subcombinations) which are patentably distinct for the reasons discussed above, and as shown by separate classification and fields of search.

For the above reasons, the petition is DENIED and the restriction requirement is deemed to be proper.

Petitioner may submit a request for reconsideration within TWO MONTHS of the date of this decision. If applicant decides not to file a request for reconsideration of this decision, then an amendment canceling non-elected claims 36- 50 must be timely filed in order for the examiner to allow the case. The application will be held to await a response.



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